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09/761,040	01/16/2001	Matti Salmi	460-010076-US(PAR)	4245
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Perman & Green, LLP 99 Hawley Lane Stratford, CT 06614				
EXAMINER				
MISFIN, YEMANE				
ART UNIT		PAPER NUMBER		
2444				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/761,040

**Applicant(s)**

SALMI ET AL.

**Examiner**

Yemane Mesfin

**Art Unit**

2444

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 February 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 6-12 and 14-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-12 and 14-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 November 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/C.3)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 02/16/2010 has been entered. Claims 1-4, 6-12 and 14-26 are pending.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 1 calls for a process/method comprising, defining presentation parameters for..., determining a reference to a location of the at least one multimedia component and supplementing the first message with a file comprising the presentation parameters and the reference to form a second message (See method steps in claim 1). This claim is rejected under 35 U.S.C. 101. While the claims recite a series of steps or acts to be performed, a statutory "process" under 35 U.S.C 101 must be tied to a particular machine, or (2) transform underlining subject matter (such as article or material) to a different state or thing [see page 10 of In Re Bilski 88 USPQ2d 1385]. The instant claim is neither positively tied to a particular machine that accomplishes the claimed method steps

nor transforms underlining subject matter, and therefore does not qualify as a statutory process. The claimed steps as recited do not require an apparatus/machine and could be reasonably interpreted by one of ordinary skill in the art to mean a series of steps that could be performed manually/mentally requiring simple manual construction or formation of desired presentation parameters (specify how and in what order one would want to see a message), determining a reference to a location (address or link lookup) without actually utilizing a machine. Further, there is no apparent transformation of underlining subject matter from one state to another.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4, 6-12 and 14-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Jaisimha et al. (U.S. Patent Number 6,487,663) hereinafter “Jaisimha” in view of Jerding et al., (US Patent Number 7,308,697) hereinafter referred to as “Jerding”.

As per claim 1, Jaisimha disclosed a method comprising, defining presentation parameters for at least one multimedia component included in first message (column 7 lines 18-25), the first message comprising address data indicative of a recipient of the first message (column 8 lines 48-50 and column 9 lines 56-67); determining a reference to a location of said the at least one multimedia component within the first message (column 7 lines 18-25, having therein a location reference to the enclosed components in the message); and, supplementing the first message with a file comprising the presentation parameters and the reference to form a second message.

Jaisimha disclosed the invention substantially as recited. However, does not explicitly recite “supplementing the first message with a file comprising the presentation parameters and the reference to form a second message”. However, as evidenced by the teachings of Jerding, supplementing one message with a file comprising presentation parameters and the reference to form a second message was known in the art at the time the invention was made (see at least Jerding, column 2 lines 58-60, column 3 lines 27-39, column 4 lines 26-45 and column 7 lines 19-45, Jerding disclosed receiving a first message with selected presentation parameters for presentation of a message and supplementing the message with a presentation file having therein presentation parameters included therein to generate a second message, the second message comprising the attached message component and corresponding presentation file integrated all together as one message). Thus, it is respectfully submitted that it would have been obvious to one of ordinary skill in the art to take the teachings of Jerding related to formation of a second message, the second message comprising the attached message component and corresponding presentation file integrated all together as one message as described above and have modified the teachings of Jaisimha with a motivation to “create a message configuration which defines how the message content is presented to the subscribers/users” (see Jerding column 6 lines 9-10).

As per claim 2, the already combined teachings of Jaisimha and Jerding disclosed the invention as recited, wherein the file is set up in a terminal configured to transmit the second message (Jaisimha column lines 1-13; Jerding column 6 lines 7-29).

As per claim 3, the already combined teachings of Jaisimha and Jerding disclosed the invention as recited, receiving the first message at a multimedia message service center of a multimedia message transmission system; and, supplementing the first message with the file at the

multimedia message service center (Jaisimha Figure 3, showing a multimedia server “MMSC” sending multimedia messages to a mobile station and, See Column 7, Lines 1-23 a presentation model of W3C’s used in presenting the multimedia messages at a mobile user terminal).

As per claim 4, the already combined teachings of Jaisimha and Jerding disclosed the invention as recited, further comprising forming the file using an SMIL format (Jaisimha column 7 lines 1-23).

As per claim 6, the already combined teachings of Jaisimha and Jerding disclosed the invention as recited, wherein the reference comprises a search address of the at least one multimedia component (Column 7, Lines 18-19, Jaisimha disclosed a “src” or a source of the components used to search and execute the components contained in the message and See Figure 3, showing a remote search locations for the components to be played or displayed on the mobile terminal).

As per claim 7, the already combined teachings of Jaisimha and Jerding disclosed the invention as recited, wherein the at least one multimedia component comprises visual information, and the presentation parameters comprise information about displaying the at least one multimedia component (Jaisimha column 7 lines 18-19; see also Jerding column 6 lines 7-28 & column 7 lines 19-43)

As per claim 8, the already combined teachings of Jaisimha and Jerding disclosed the invention as recited, wherein the at least one multimedia component comprises audio information and the presentation parameters include data about converting the at least one multimedia component onto audio information (Jaisimha column 7 lines 1-23)

As per claim 9, the already combined teachings of Jaisimha and Jerding disclosed the invention as recited, wherein the presentation parameter include information about a time of effect of the at least one multimedia component (This limitation is inherent future of the known presentation model SMIL [Synchronized Media Integration Language], according to the specification of SMIL 1.0 published in 1998; W3C defines SMIL as “a markup language designed to present multiple media files together. For instance, instead of using a video with an integrated soundtrack, a separate video and sound file can be used and synchronized via SMIL. This allows users to choose different combinations, e.g., to get a different language sound track, and permits text transcripts to be optionally presented; both options have accessibility benefits.” SMIL allows integrating a set of independent multimedia objects into a synchronized multimedia; see also Jerding column 7 lines 19-45).

As per claim 10, the already combined teachings of Jaisimha and Jerding disclosed the invention as recited, wherein the first message comprises at least two parameters include information about the mutual synchronization of the at least two multimedia components (This claim limitation is rejected for the same reason claim 9 is rejected above).

As per claim 11, the already combined teachings of Jaisimha and Jerding disclosed the invention as recited, wherein the first message comprises at least two multimedia pages, and the presentation parameters include data about the order of presenting the at least two multimedia pages (Jaisimha Column 7, Lines 18-19; and Jerding column 7 lines 19-45).

Claims 12, 14-26 recite limitations substantially the same as in claims 1-4 and 6-11 disclosed above. Thus, these claims are rejected with the same rationale claims 1-4 and 6-11 are rejected above.

***Response to Arguments***

5. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection, which better address the claims as amended.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yemane Mesfin whose telephone number is 571-272-3927. The examiner can normally be reached on M- F, from 9 to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on 572-272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Yemane Mesfin/  
Primary Examiner, Art Unit 2444